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OFFICE OF PETITIONS

ON PETITION

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In re Application of:
LIN, VERNON WEN-HAU LIN
Application No. 09/326,853
Filed: 06/07/1999
For: TREATMENT OF EXCRETORY
PROBLEMS

This is a decision on the April 10, 2001 petition under 37 C.F.R. §1.137(a).

RULES

37 C.F.R. §1.137 Revival of abandoned application, terminated reexamination proceeding, or lapsed patent.

(a) Unavoidable. If the delay in reply by applicant or patent owner was unavoidable, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(l);
- (3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

FACTS

This application became abandoned by operation of law due to Petitioner's failure to complete his reply within the one (1) month time period set by the January 17, 2001 notice of non-responsiveness. A notice of abandonment was mailed on April 9, 2001.

With regard to establishing unavoidable delay within the meaning of 37 C.F.R. §1.137(a)(3), the Commissioner may revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable."¹ Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in

¹ 35 U.S.C. §133.

determining if the delay was unavoidable.² In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."³ Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.⁴ The burden of showing the cause of the delay is on the person seeking to revive the application.⁵

There are three periods to be considered in treating a petition to revive under 37 C.F.R. §1.137(a):

- (1) the delay in reply that originally resulted in the abandonment;
- (2) the delay in filing an initial petition pursuant to 37 C.F.R. §1.137 to revive the application; and
- (3) the delay in filing a grantable petition pursuant to 37 C.F.R. §1.137 to revive the application.

This particular application appears to turn on period (1) above.

With respect to the first period, an application is "unavoidably" abandoned only where Petitioner, or counsel for Petitioner, takes all action necessary for a proper response to the outstanding office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the office.⁶

Petitioner alleges that the outstanding office action was mailed on July 13, 2000. Petitioner "did not observe that the second page of the Official Action...was not present". Nevertheless, Petitioner timely filed his reply on October 16, 2000.⁷

On January 17, 2001, Examiner Lacyk mailed an advisory action notifying Applicant that the reply did not adequately address the rejection under 35 U.S.C. §112. The action set a one (1) month deadline for replying, running from the date of mailing of the advisory action.

² *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) ("the term 'unavoidable' is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); *In re Mattullath*, 38 App. D.C. 497, 514-15 (D.C. Cir 1912); *Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

³ *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982.

⁴ *Haines v. Quigg*, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

⁵ *Smith v. Mossinghoff*, *Id.*

⁶ *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

⁷ The reply included a certificate of mailing dated October 11, 2000, which under 37 C.F.R. §1.8, was timely.

On February 15, 2001, Petitioner attempted to make telephone contact with Examiner Lacyk to better determine why the October 16, 2000 reply was not accepted. However, Applicant Petitioner learned that Examiner Lacyk was on leave and would not return until after the Washington's Day holiday, which fell on February 19, 2001. When Petitioner was finally able to contact Examiner Lacyk on February 26, 2001, he learned of the page allegedly missing from his copy of the July 13, 2000 office action.

However, the claim that the July 13, 2000 office action was not mailed in its entirety is unsubstantiated. Specifically, there is no evidence of any irregularity in the mailing of the action. In the absence of any irregularity, there is a strong presumption that the action was properly mailed to counsel at the address of record. This presumption may be overcome by a showing that the action was not in fact received. However, in the absence of a proper (documented) showing in this regard, the presumption is that Petitioner received the office action and simply did not file a proper reply. Such a circumstance does not warrant waiver of the time period for filing a proper reply.

Furthermore, Petitioner's inability to reach the Examiner before the deadline is also unpersuasive. Petitioner could have avoided missing the deadline by calling Examiner Lacyk at some point earlier than two days before the deadline was to pass. By waiting until two days before the deadline for replying, Petitioner assumed the risk that he would be unable to reach the Examiner before the passage of the deadline.

In view of the foregoing, this petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted.⁸ The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(a)". This is **not** a final agency action within the meaning of 5 U.S.C. §704.

Applicant is encouraged to consider filing a petition under 37 C.F.R. §1.137(b) to revive an application unintentionally abandoned. That rule provides that where the delay in replying was unintentional, a petition may be filed to revive the application or lapsed patent, which will be grantable if accompanied by:

- (1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
- (2) The petition fee as set forth in 37 C.F.R. §1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

⁸ See 37 C.F.R. §1.137(d).

(4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c).


Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries concerning this matter may be directed to the undersigned in the Office of Petitions at (703) 306-5593.



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